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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,460	10/10/2001	Andrew Ernest Fano	10022/187	4729

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EXAMINER

JABR, FADEY S

ART UNIT	PAPER NUMBER
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3628

MAIL DATE	DELIVERY MODE
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08/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/975,460	Applicant(s) FANO, ANDREW ERNEST	
	Examiner Fadey S. Jabr	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-25, 28-34, 36-40, 42-45, 49-54, 56-59, 61-65, 67, 68, 70, 71, 73-80 and 82-93 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 20-25,28-34,36-40,42-45,49-54,56-59,61-65,67,68,70,71,73-80 and 82-93.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 June 2007 has been entered.

Status of Claims

Claims **26-27, 35, 41, 46-48, 55, 66, 72** and **81** have been cancelled. Claims **82-93** have been newly added. Claims **20-25, 28-34, 36-40, 42-45, 49-54, 56-59, 61-65, 67-68, 70-71, 73-80** and **82-93** remain pending and are presented for examination.

Response to Arguments

2. Applicant's arguments with respect to claims 20, 28, 36, 42, 49, 56, 61, 67 and 70 have been considered but are moot in view of the new ground(s) of rejection.
3. Applicant's amendments filed 12 June 2007 have been fully considered and are therefore withdrawn.
4. Applicant's arguments with respect to the Double Patenting rejection have been fully considered but they are not persuasive, thus the Double Patenting rejection is upheld.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims **20, 28, 36, 42, 49, 56, 61, 67** and **70** are rejected on the ground of nonstatutory double patenting over claims **1** and **8** of U. S. Patent No. 6,317,718 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: displaying the items of interest and their location, along with the best local price to a user.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 20, 24-25, 28, 32-34, 36-40, 42, 49, 53-54, 56-59, 61-65, 67-68, 70-71, 73-80 and 82-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollenberg, U.S. Patent No. 6,091,956 in view of Fusz et al., Pub. No. US2007/0078728 A1, hereinafter referred to as Hollenberg and Fusz respectively.

As per Claims 20, 24-25, 28, 32-33, 36, 38-40, 42, 49, 53, 56, 58-59, 61, 64-65, 67-68, 70-71, 74-75, 78-79 and 92-93, Hollenberg discloses a method and system comprising:

- obtaining information identifying an item of merchandise that the user desires to purchase (C. 7, lines 34-40, C. 9, lines 15-22, C. 10, 25-31);
- determining a physical location of the user (C. 1, lines 45-54, C. 9, lines 6-10);
- querying a computerized network of information utilizing a query based on the information identifying the item of merchandise that the user desires to purchase and the physical location of the user (C. 13, lines 9-21);

Hollenberg fails to *explicitly* disclose identifying the *best local price* in response to the query, the best local price comprising a lowest price at which the item of merchandise that the user desires to purchase is available for purchase as between multiple retailers proximate to the user; and displaying the *best local price* and an identification of a retailer from among the multiple

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retailers proximate to the user at which the item of merchandise that the user desires to purchase is available for purchase at the best local price. However, Hollenberg discloses a handheld device with GPS capability for determining the user's current location. Hollenberg also discloses shoppers having difficulty searching for price and stock information within a store. The system allows users to receive services like maps and other aids to help them find their way around the store or shopping mall to the desired merchandise or store. Hollenberg also discloses the proximate information is correlated with the user's options and filters. Further, Hollenberg discloses a graphical display unit for displaying location and price information (C. 1, lines 55-63, C. 4, lines 34-65, C. 7, lines 27-40, C. 15, line 65 – C. 16, line 4). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Hollenberg and include providing the user with price information.

Moreover, Fusz teaches enabling a potential product purchaser to easily and quickly review specific product configurations of interest in combination with final pricing information for those same products in a particular geographic region. Fusz also teaches overcoming the need for customers to visit several stores to determine the best price in a geographic area (0002, 0003, 0010). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Hollenberg and include providing the user with the best price in a geographic region as taught by Fusz, because as Hollenberg discloses receiving information about price and availability of a product at a local store is often frustratingly difficult to get; while the system of Hollenberg allows for quickly locating products (C. 2, lines 9-10).

As per **Claims 34, 54**, Hollenberg discloses a code segment that recognizes patterns to enhance the location of pertinent information (C. 10, lines 25-31).

As per **Claims 37, 57**, Hollenberg discloses parsing the information identifying the user profile based on predefined criteria to create the query (C. 13, lines 9-17).

As per **Claims 62-63, 82, 91**, Hollenberg discloses wherein the input further comprises shopping preferences of the user and querying a computerized network based on the shopping preferences (C. 13, lines 9-17).

As per **Claim 73**, Hollenberg fails to *explicitly* disclose that the user profile is stored on a wireless handheld device. However, Hollenberg discloses a mobile computer with memory, storage, drives, and RAM units, and computer programs to provide for efficient situation information exchange between them (C. 5, lines 13-27, C. 13, lines 9-16). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Hollenberg and include storing pertinent information on a mobile computer, because it allows for the efficient exchange of user and system information for querying the system.

As per **Claims 76 and 80**, Hollenberg discloses updating the map as the user moves to show a new physical location of the user relative to the physical location of specific retailers proximate to the new physical location of the user (C. 8, lines 65-67).

As per **Claim 77**, Hollenberg fails to *explicitly* disclose pinpointing the physical location of specific of the user with an accuracy of approximately 100 feet or less. However, Hollenberg discloses that the GPS information is processed by a differential computer to derive the corrections necessary to produce mappably accurate global position or coordinates of the mobile device (C. 18, lines 44-49). Further, Hollenberg discloses that the system can aid a user in finding their way around a store or a shopping mall (C. 7, lines 34-40). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Hollenberg and include a GPS system with accuracy to pinpoint merchandise in a store, because it allows the system to aid the user in pinpointing the location of a desired product.

As per **Claims 83-90**, Hollenberg discloses:

- transmitting the physical location of the user and the user profile to a retailer-based agent comprising identifications of physical locations of the multiple retailers proximate to the user and items of merchandise available at the multiple retailers proximate to the user (C. 9, lines 6-26, C. 10, lines 12-36, C. 13, lines 9-16, also see Claims 8-10); and
- receiving from the retailer-based agent the customized offer for sale of the item of merchandise offered for sale from a retailer proximate the user, where the item of merchandise offered for sale from a retailer proximate to the user corresponds to the item of merchandise that the user desires to purchase (C. 9, lines 6-26, C. 10, lines 12-36, C. 13, lines 9-16, also see Claims 8-10).

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9. Claims **21-23, 29-31, 43-45 and 50-52** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollenberg in view of Fusz as applied to claims 20, 28, 36, 42, 49, 56, 61, 67 and 70 above, and further in view of Swartz et al., US2002/0050526 A1, hereinafter referred to as Swartz respectively.

As per **Claims 21-23, 29-31, 43-45 and 50-52**, Hollenberg fails to *explicitly* disclose a shopping list. However, Hollenberg discloses an on-line information search system in which user's interests, entered as lists of keywords or search terms, are automatically searched for their occurrence (C. 10, lines 25-31). Further, the system provides approximate information of items the user desires using a handheld multiple-use electronic device (C. 9, lines 11-19). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Hollenberg and include a list of keywords for what the user desires, because it allows the system to determine what items the user desires in order to provide him/her with the pertinent information.

Moreover, Swartz teaches a portable shopping and order fulfillment system comprising a portable terminal and data communication system which may be used in a portable shopping and order fulfillment system. The system includes a graphical data selection system for ordering items and creating shopping lists (0003, 0007, 0011). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Hollenberg and include creating a shopping list in which is downloaded to a portable terminal as taught by Swartz, because it aids the user in determining which products the user

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desires when shopping by saving the list and allowing the items to be collected for pick-up or delivery.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr
Examiner
Art Unit 3628

FSJ

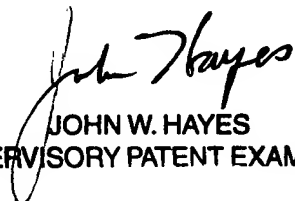
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JOHN W. HAYES
SUPERVISORY PATENT EXAMINER